UNITED STATES PATENT AND TRADEMARK OFFICE

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/630,497</td><td>Applicant(s)
LUBART, BARRY P.</td></tr>
<tr><td>Examiner
Daniel P. Vetter</td><td>Art Unit
3628</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 July 2003</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *7/29/2003, 5/23/2005*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claims 1-41 are pending in this application.

Drawings

1.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 330. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet"   or "New Sheet"   pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2.   Claims 3 and 22 are objected to because of the following informalities: "sub profiles *comprise* a franking profile, a naming profile or a dynamic function profile" appears to be a grammatical error. Appropriate correction is required.

3.   Claims 20-39 are objected to because of a confusing preamble. The claims are

purported to be directed to a "service," which is not a statutory class of invention.

However, because the limitations of the claims are listed as steps, for examination

purposes Examiner is interpreting this group of claims to be a process.

4.   Claims 32 and 39 are objected to as being substantial duplicates of one another.

Claim 39 repeats the limitation of claim 32 and is dependent on the same claim, but

does not include the words "for the user." It is unclear what, if any, difference in scope

exists between the two claims.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claims 3-11, 17, 22-30, 36, and 41 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

7.   Claim 3 is rejected because it uses an improper alternative limitation format. The

term "comprise" in line 2 leaves the group of: a franking profile, a naming profile or a

dynamic function profile open-ended and makes the scope of the claim vague and

indefinite. Proper alternative limitations use close-ended language such as "is" or

"consists of." MPEP § 2173.05(h).

8.   Claims 4-11 and 17 contain the same deficiencies as claim 3 through

dependency and, as such, are rejected for the same reasons.

9.   Claim 7 is rejected because it uses an improper alternative limitation format. The

term "comprises" in line 2 leaves the group of: a follow me mail service, a mail delivery

notification service, a vanity stamp service or a bulk mail service open-ended and

makes the scope of the claim vague and indefinite. Proper alternative limitations use

close-ended language such as "is" or "consists of." MPEP § 2173.05(h).

10.   Claims 8-11 contain the same deficiencies as claim 7 through dependency and,

as such, are rejected for the same reasons.

11.   Claim 22 is rejected because it uses an improper alternative limitation format.

The term "comprise" in line 2 leaves the group of: a franking profile, a naming profile or

a dynamic function profile open-ended and makes the scope of the claim vague and

indefinite. Proper alternative limitations use close-ended language such as "is" or

"consists of." MPEP § 2173.05(h).

12.   Claims 23-30 and 36 contain the same deficiencies as claim 22 through

dependency and, as such, are rejected for the same reasons.

13.   Claim 26 is rejected because it uses an improper alternative limitation format.

The term "comprises" in line 2 leaves the group of: a follow me mail service, a mail

delivery notification service, a vanity stamp service or a bulk mail service open-ended

and makes the scope of the claim vague and indefinite. Proper alternative limitations

use close-ended language such as "is" or "consists of." MPEP § 2173.05(h).

14.   Claims 27-30 contain the same deficiencies as claim 26 through dependency

and, as such, are rejected for the same reasons.

15.   Claim 41 is rejected because it is unclear if software alone is capable of

performing the step of executing the selected mail services, as some of these mail

services listed in the specification seem to require physical acts.

Claim Rejections - 35 USC § 101

16.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

17.   Claim 41 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claim 41 is directed to software *per se*, which

is not one of the statutory categories of invention. To qualify as statutory subject matter,

software must be embodied on a physical platform as claimed.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1-3, 5-7, 10, 13-14, 18-22, 24-26, 29, 32-33, and 37-41 are rejected

under 35 U.S.C. 102(b) as being anticipated by Lee, et al., U.S. Pat. Pub. No.

2002/0029152 (Reference A of the attached PTO-892).

20. As per claim 1, Lee, et al. teaches a method for routing a mail object in a postal

service to a designated person, the method comprising the steps of: locating a user

profile from a registered pseudo name displayed on the mail object (¶ 0006); and

executing one or more mail services as selected by a user in the user profile (¶ 0007).

For all purposes in applying this reference, Examiner is interpreting an electronic

address and identifier mark as a pseudo name (see ¶ 0014).

21. As per claim 2, Lee, et al. teaches the method of claim 1 as described above.

Lee, et al. further teaches the profile comprises one or more sub profiles (¶ 0020).

Examiner is interpreting premium service records as sub profiles.

22.   As per claim 3, Lee, et al. teaches the method of claim 2 as described above.

Lee, et al. further teaches the one or more sub profiles comprise a franking profile, a

naming profile or a dynamic mail function profile (¶ 0020). Examiner is interpreting

premium service records a dynamic function profile.

23.   As per claim 5, Lee, et al. teaches the method of claim 3 as described above.

Lee, et al. further teaches the naming profile comprises an electronic address (¶ 0014).

A name and address, and return name and address information for the registered

pseudo name are all recitations of non-functional descriptive material. Non-functional

descriptive material cannot lend patentability to an invention that would have otherwise

been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862,

1864 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed.

Cir. 1983) (when descriptive material is not functionally related to the substrate, the

descriptive material will not distinguish the invention from the prior art in terms of

patentability).

24.   As per claim 6, Lee, et al. teaches the method of claim 3 as described above.

Lee, et al. further teaches the dynamic mail function profile comprises a list of mail

services available to the user of the registered pseudo name (¶ 0020).

25.   As per claim 7, Lee, et al. teaches the method of claim 6 as described above.

Lee, et al. further teaches the dynamic mail service comprises a follow me mail service,

a mail delivery notification service, a vanity stamp service or a bulk mail service (¶ 0031,

teaching a delivery notification service).

26.   As per claim 10, Lee, et al. teaches the method of claim 7 as described above.

Lee, et al. further teaches the vanity stamp service comprises registering a personalised

image to be displayed on the mail object (¶ 0018).

27.   As per claim 13, Lee, et al. teaches the method of claim 1 as described above.

Lee, et al. further teaches the pseudo name is a unique pseudo name for the user (¶

0014).

28.   As per claim 14, Lee, et al. teaches the method of claim 1 as described above.

Lee, et al. further teaches the pseudo name is registered via an Internet registration

service or a central reservation facility (¶ 0023).

29.   As per claim 18, Lee, et al. teaches the method of claim 1 as described above.

Lee, et al. further teaches reading the registered pseudo name with a scanning system

(¶ 0014).

30.   As per claim 19, Lee, et al. teaches the method of claim 18 as described above.

Lee, et al. further teaches the scanning system further comprises an optical character

recognition scanner (¶ 0017).

31.   As per claim 20, Lee, et al. teaches a postal service for routing a mail object to a

designated person, the service comprising: registering a pseudo name to be displayed

on the mail object and a user profile for selecting one or more mail services (¶ 0034);

determining the registered pseudo name displayed on the mail object to locate the user

profile (¶ 0006); and executing one or more mail services as defined in the user profile

(¶ 0007).

32.   As per claim 21, Lee, et al. teaches the service of claim 20 as described above.

Lee, et al. further teaches the profile comprises one or more sub profiles (¶ 0020).

33.   As per claim 22, Lee, et al. teaches the service of claim 21 as described above.

Lee, et al. further teaches the one or more sub profiles comprise a franking profile, a

naming profile or a dynamic mail function profile (¶ 0020). Examiner is interpreting

premium service records a dynamic function profile.

34.   As per claim 24, Lee, et al. teaches the service of claim 22 as described above.

Lee, et al. further teaches the naming profile comprises an electronic address (¶ 0014).

A name and address, and return name and address information for the registered

pseudo name are all recitations of non-functional descriptive material. Non-functional

descriptive material cannot lend patentability to an invention that would have otherwise

been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862,

1864 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed.

Cir. 1983) (when descriptive material is not functionally related to the substrate, the

descriptive material will not distinguish the invention from the prior art in terms of

patentability).

35.   As per claim 25, Lee, et al. teaches the service of claim 22 as described above.

Lee, et al. further teaches the dynamic mail function profile comprises a list of mail

services available to the user of the registered pseudo name (¶ 0020).

36.   As per claim 26, Lee, et al. teaches the service of claim 25 as described above.

Lee, et al. further teaches the dynamic mail services comprises a follow me mail

service, a mail delivery notification service, a vanity stamp service or a bulk mail service

(¶ 0031, teaching a delivery notification service).

37.   As per claim 29, Lee, et al. teaches the service of claim 26 as described above.

Lee, et al. further teaches the vanity stamp service comprises registering a personalised

image to be displayed on the mail object (¶ 0018).

38.   As per claim 32, Lee, et al. teaches the service of claim 20 as described above.

Lee, et al. further teaches the pseudo name is a unique pseudo name for the user (¶

0014).

39.   As per claim 33, Lee, et al. teaches the service of claim 20 as described above.

Lee, et al. further teaches the pseudo name is registered via an Internet registration

service or a central reservation facility (¶ 0023).

40.   As per claim 37, Lee, et al. teaches the service of claim 20 as described above.

Lee, et al. further teaches reading the registered pseudo name with a scanning system

(¶ 0014).

41.   As per claim 38, Lee, et al. teaches the service of claim 37 as described above.

Lee, et al. further teaches the scanning system further comprises an optical character

recognition scanner (¶ 0017).

42.   As per claim 39, Lee, et al. teaches the service of claim 20 as described above.

Lee, et al. further teaches the pseudo name is a unique pseudo name (¶ 0014).

43.   As per claim 40, Lee, et al. teaches a system for routing a mail object in a postal

service to a designated person, the system comprising: means for registering a pseudo

name and selecting one or more mail services in a user profile (¶ 0034); means for

determining a registered pseudo name to locate a user profile associated with the

registered pseudo name (¶ 0006); and means for executing the one or mail services in

the user profile (¶ 0007).

44.   As per claim 41, Lee, et al. teaches a computer program product directly

loadable into the internal memory of a digital computer, comprising software code

portions for performing the steps of: locating a user profile having a selected mail

service, from a registered pseudo name displayed on a mail object (¶¶ 0020, 0006); and

executing the selected mail service (¶¶ 0020, 0007).

Claim Rejections - 35 USC § 103

45. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

46. Claims 4, 8, 12, 15-17, 23, 27, 31, and 34-36 rejected under 35 U.S.C. 103(a) as

being unpatentable over Lee, et al. in view of Lorch, et al., Intl. Pub. No. WO 02/51051

(Reference 1 of IDS submitted May 23, 2005).

47. As per claim 4, Lee, et al. teaches the method of claim 3 as described above.

Lee, et al. does not explicitly teach the franking profile comprises a designated method

of payment for the mail object. Lorch, et al. teaches the franking profile comprises a

designated method of payment for the mail object (page 23, lines 9-11). It would have

been prima facie obvious to one having ordinary skill in the art at the time of invention to

incorporate the franking profile comprises a designated method of payment for the mail

object into the method taught by Lee, et al. to provide pre-paid postage functionality (as

taught by Lorch, et al.; page 23, lines 7-8).

48. As per claim 8, Lee, et al. teaches the method of claim 7 as described above.

Lee, et al. does not teach the follow me mail service comprises modifying the naming

profile of the registered pseudo name to update information to enable redirection of the mail object. Lorch, et al. teaches the follow me mail service comprises modifying the naming profile of the registered pseudo name to update information to enable redirection of the mail object (page 22, lines 16-17). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the follow me mail service comprises modifying the naming profile of the registered pseudo name to update information into the method taught by Lee, et al. to enable redirection of the mail object to manage mail flow without having to change the user's pseudo name (as taught by Lorch, et al.; page 18, lines 11-13).

49.   As per claim 12, Lee, et al. teaches the method of claim 2 as described above. Lee, et al. does not teach the profile and the one or more sub profiles comprise a valid date range for when the profile and the one or more sub profiles are active. Lorch, et al. teaches the profile and the one or more sub profiles comprise a valid date range for when the profile and the one or more sub profiles are active (page 28, line 16). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the profile and the one or more sub profiles comprise a valid date range for when the profile and the one or more sub profiles are active into the method taught by Lee, et al. in order to direct mail to proper and valid locations (as taught by Lorch, et al.; page 22, lines 14-17).

50.   As per claim 15, Lee, et al. teaches the method of claim 1 as described above.

Lee, et al. does not teach the pseudo name is linked to the profile and the user

accesses the linked profile to modify the information contained in one or more sub

profiles. Lorch, et al. teaches the pseudo name is linked to the profile and the user

accesses the linked profile to modify the information contained in one or more sub

profiles (page 18, lines 12-13). It would have been prima facie obvious to one having

ordinary skill in the art at the time of invention to incorporate the pseudo name is linked

to the profile and the user accesses the linked profile to modify the information

contained in one or more sub profiles into the method taught by Lee, et al. to manage

mail flow to the correct address (as taught by Lorch, et al.; page 18, lines 10-12).

51.   As per claim 16, Lee, et al. in view of Lorch, et al. teaches the method of claim 15

as described above. Lorch, et al. further teaches the modified profile is updated in a

data store (page 18, lines 12-13; page 20, lines 3-6) and made available to the postal

service to be performed as specified by the user in the modified profile (page 21, lines

12-14). It would have been prima facie obvious to one having ordinary skill in the art at

the time of invention to incorporate the modified profile is updated in a data store and

made available to the postal service to be performed as specified by the user in the

modified profile into the method taught by Lee, et al. in view of Lorch, et al. to manage

mail flow to the correct address (as taught by Lorch, et al.; page 18, lines 10-12).

52.   As per claim 17, Lee, et al. in view of Lorch, et al. teaches the method of claim 4 as described above. Lorch, et al. further teaches the franking profile is accessed to determine a designated method of payment based on a sender name or a receiver name in the naming profile (page 23, lines 6-11). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the franking profile is accessed to determine a designated method of payment based on a sender name or a receiver name in the naming profile into the method taught by Lee, et al. in view of Lorch, et al. to provide pre-paid postage functionality (as taught by Lorch, et al.; page 23, lines 7-8).

53.   As per claim 23, Lee, et al. teaches the service of claim 22 as described above. Lee, et al. does not explicitly teach the franking profile comprises a designated service of payment for the mail object. Lorch, et al. teaches the franking profile comprises a designated service of payment for the mail object (page 23, lines 9-11). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the franking profile comprises a designated service of payment for the mail object into the service taught by Lee, et al. to provide pre-paid postage functionality (as taught by Lorch, et al.; page 23, lines 7-8).

54.   As per claim 27, Lee, et al. teaches the service of claim 26 as described above. Lee, et al. does not teach the follow me mail service comprises modifying the naming

profile of the registered pseudo name to update information to enable redirection of the mail object. Lorch, et al. teaches the follow me mail service comprises modifying the naming profile of the registered pseudo name to update information to enable redirection of the mail object (page 22, lines 16-17). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the follow me mail service comprises modifying the naming profile of the registered pseudo name to update information into the service taught by Lee, et al. to enable redirection of the mail object to manage mail flow without having to change the user's pseudo name (as taught by Lorch, et al.; page 18, lines 11-13).

55.   As per claim 31, Lee, et al. teaches the service of claim 21 as described above. Lee, et al. does not teach the profile and the one or more sub profiles comprise a valid date range for when the profile and the one or more sub profiles are active. Lorch, et al. teaches the profile and the one or more sub profiles comprise a valid date range for when the profile and the one or more sub profiles are active (page 28, line 16). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the profile and the one or more sub profiles comprise a valid date range for when the profile and the one or more sub profiles are active into the service taught by Lee, et al. in order to direct mail to proper and valid locations (as taught by Lorch, et al.; page 22, lines 14-17).

56.   As per claim 34, Lee, et al. teaches the service of claim 20 as described above.

Lee, et al. does not teach the pseudo name is linked to the profile and the user

accesses the linked profile to modify the information contained in one or more sub

profiles. Lorch, et al. teaches the pseudo name is linked to the profile and the user

accesses the linked profile to modify the information contained in one or more sub

profiles (page 18, lines 12-13). It would have been prima facie obvious to one having

ordinary skill in the art at the time of invention to incorporate the pseudo name is linked

to the profile and the user accesses the linked profile to modify the information

contained in one or more sub profiles into the service taught by Lee, et al. to manage

mail flow to the correct address (as taught by Lorch, et al.; page 18, lines 10-12).

57.   As per claim 35, Lee, et al. in view of Lorch, et al. teaches the service of claim 34

as described above. Lorch, et al. further teaches the modified profile is updated in a

data store (page 18, lines 12-13; page 20, lines 3-6) and made available to the postal

service to be performed as specified by the user in the modified profile (page 21, lines

12-14). It would have been prima facie obvious to one having ordinary skill in the art at

the time of invention to incorporate the modified profile is updated in a data store and

made available to the postal service to be performed as specified by the user in the

modified profile into the service taught by Lee, et al. in view of Lorch, et al. to manage

mail flow to the correct address (as taught by Lorch, et al.; page 18, lines 10-12).

58.   As per claim 36, Lee, et al. in view of Lorch, et al. teaches the service of claim 23

as described above. Lorch, et al. further teaches the franking profile is accessed to

determine a designated service of payment based on a sender name or a receiver

name in the naming profile (page 23, lines 6-11). It would have been prima facie

obvious to one having ordinary skill in the art at the time of invention to incorporate the

franking profile is accessed to determine a designated service of payment based on a

sender name or a receiver name in the naming profile into the service taught by Lee, et

al. in view of Lorch, et al. to provide pre-paid postage functionality (as taught by Lorch,

et al.; page 23, lines 7-8).

59.   Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lee, et al.

60.   As per claim 9, Lee, et al. teaches the method of claim 7 as described above.

Lee, et al. further teaches the displaying the registered pseudo name in a field on the

mail object (¶ 0024) and sending an automated electronic delivery notice to an email

address (¶ 0024). Lee, et al. does not teach that the pseudo name appears in a return

field, however it would have been prima facie obvious to one having ordinary skill in the

art at the time of invention to incorporate that the pseudo name appears in a return field

into the method taught because this is merely a choice of arrangement and cannot be

relied upon to distinguish the claim from the prior art as it is not critical for and would not modify the operation of the method as claimed. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

61.   As per claim 28, Lee, et al. teaches the service of claim 26 as described above. Lee, et al. further teaches the displaying the registered pseudo name in a field on the mail object (¶ 0024) and sending an automated electronic delivery notice to an email address (¶ 0024). Lee, et al. does not teach that the pseudo name appears in a return field, however it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate that the pseudo name appears in a return field into the service taught because this is merely a choice of arrangement and cannot be relied upon to distinguish the claim from the prior art as it is not critical for and would not modify the operation of the service as claimed. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

62.   Claims 11 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, et al. in view of Official Notice.

63.   As per claim 11, Lee, et al. teaches the method of claim 7 as described above. Lee, et al. does not teach not sending the mail object to a registered pseudo name having bulk mail blocked. Official Notice is taken that it would have been prima facie

obvious to one having ordinary skill in the art at the time of invention to incorporate not

sending the mail object to a registered pseudo name having bulk mail blocked into the

method taught by Lee, et al. because it is common in the art to have opt-out lists of

potential customers that do not wish to receive bulk mailings.

64.   As per claim 30, Lee, et al. teaches the service of claim 26 as described above.

Lee, et al. does not teach not sending the mail object to a registered pseudo name

having bulk mail blocked. Official Notice is taken that it would have been prima facie

obvious to one having ordinary skill in the art at the time of invention to incorporate not

sending the mail object to a registered pseudo name having bulk mail blocked into the

service taught by Lee, et al. because it is common in the art to have opt-out lists of

potential customers that do not wish to receive bulk mailings.

Conclusion

65.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Schumacher, U.S. Pat. No. 5,058,030 (Reference B of the

attached PTO-892) teaches a system and method for optimizing mail processing in

which databases are established at the data center of profiles of publishers and their

current and prospective activities, and the information is used by the data center to

match publisher to inserters for particular jobs to reduce mail processing and distribution

costs, or expedite mail distribution. Walz, et al., U.S. Pat. No. 5,325,303 (Reference C

of the attached PTO-892) teaches an automated system for mail preparation and record keeping includes a data processor having a memory for storing program instructions and data including postage fees for different types of mailing, wherein the processor is programmed to receive and store a list of names and addresses to which items are to be mailed, to compute the postage fees, and to print the names and addresses successively in designated addressee areas on successive forms in the form supply; and where the processor also keeps a record for each prepared form of the addressee, an article number provided on the form, and the postage fee.

66.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571) 272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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